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REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Regarding the restriction requirement, the Examiner's point about claim 28 never having been examined is not compelling. Claim 28 is simply claim 1, which was examined, reorganized. There is no subject matter in claim 28 that was not included in claim 1 and vice versa. Consequently, while the Examiner may not technically have examined claim 28, the Examiner did examine the substance of claim 28. Therefore, it does not occasion a serious search burden on the Examiner to continue examining the full scope of claim 28.

Moreover, nothing changed in claims 4, 7, 9, 11-13 and 17 that caused their continued examination to represent a serious search burden. Although they now depend from claim 28, as claim 28 is the substantive equivalent of claim 1, claims 4, 7, 9, 11-13 and 17 are unchanged in their substantive scope, which the Examiner has already examined. Therefore, these claims should continue to be examined along with claim 28.

With respect to claims 21-25, these method claims require the composites being examined. Accordingly, if the composite claims are found to be allowable, claims 21-25 should be rejoined and examined.

Claim 2 was objected to for misspelling "comprising." In response, Applicants have corrected claim 2.

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Claims 2, 4-6, 8, 10, 15-20, 26 and 28-30 were rejected under 35 USC § 112, second paragraph, as being indefinite. In response, Applicants have canceled claim 20 and amended the remaining claims above in a manner which is believed to overcome each of the Examiner's concerns.

With respect to claim 19, if the Examiner's objection is to the word "shaped," Applicants respectfully submit that the Examiner has not adequately explained why the use of such a common, well-known word renders claim 19 indefinite. Claim 19 does not require any particular shape and, therefore, encompasses all shapes. The Examiner has not explained why this is in any way unclear. If this aspect of the rejection is maintained, then Applicants respectfully request that the Examiner explain the nature of the indefiniteness in detail.

Claims 15, 16, 18, 20, 26, 28 and 30 were rejected under 35 USC § 102(b) as being anticipated by Whitbourne et al. ("Whitbourne"), US 6,110,483. In response, Applicants respectfully submit that Whitbourne does not anticipate the instant claims.

In their previous response, Applicants argued that anticipation by Whitbourne requires not only the disclosure of the instantly claimed components, but also *their combination in the arrangement required by the instant claims*. The instant claims require that elements (a), (b) and (c) of new main claim 28 be *suspended in* element (d) of new main claim 28 *to form a composite*.

The Examiner does not disagree with the foregoing, but finds at the top of page 6 of the Office Action that "since Whitbourne teaches the same polymers and active ingredients in a

polymer composition as applicants it is inherent that the same composition *will be capable of forming a suspension.*"

Respectfully, such capability is insufficient for inherency. An examiner relying on a theory of inherency as to any particular element must make a clear case that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.*

The Examiner in finding that Whitbourne's composition is "capable" of forming a suspension finds only the "probabilities or possibilities" that *Robertson* makes crystal clear are inadequate to make out a case of inherent anticipation.

That the Examiner's attempt to find inherency here is overreaching is clear from the Examiner's statements on page 5, to wit:

"Whitbourne specifically recites that the active ingredient *depending* upon the solvent used *can be* dispersed and not dissolved within the polymer/solvent mixture, *thus* it is inherent that the active ingredient would be suspended in the polymer once the solvent was evaporated since the active ingredient can be present as discrete particles. [Emphasis added.]"

This is not inherency. A selection must be made as to solvent and even if the correct solvent is selected there is only the possibility that the active ingredient will disperse rather than

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dissolve in the polymer/solvent mixture. The Examiner has not pointed to any specific embodiment of Whitbourne where it can be said that the active ingredient is *necessarily* dispersed in the polymer/solvent mixture. In the absence of a specific embodiment *necessarily* meeting the terms of the instant claims, there cannot be inherent anticipation.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Claims 2, 4-6, 8, 10, 15-20, 26 and 28-30 were rejected under 35 USC § 103(a) as being obvious over Whitbourne in view of Watanakunakom et al. ("Watanakunakom"), J. Antimicrob. Chemother., 6: 785-791 (1980), in view of McGhee, US 2001/0051669, in view of Rozzi et al. ("Rozzi"), US 2003/0138492. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well.

None of the secondary references are relied on to teach or suggest any of the above-noted defects in Whitbourne. Consequently, the combination of Whitbourne, Watanakunakom, McGhee and Rozzi fails to make out a *prima facie* case of obviousness.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,
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